

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

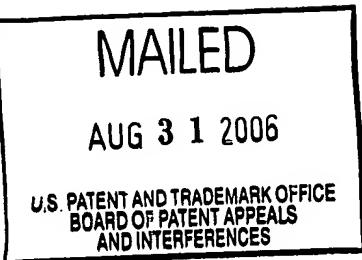
Ex parte CATHERINE LIN-HENDEL

Appeal No. 2006-1190  
Application No. 10/052,692

ON BRIEF

Before RUGGIERO, MACDONALD, and HOMERE, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.



**DECISION ON APPEAL**

This is a decision on the appeal from the final rejection of claims 1-39.

The disclosed invention relates to the displaying and navigating through stored information via a browser by automatically scrolling the contents of information media without requiring user input. The automatic scrolling is controlled by placing a cursor on various control icons, such as the ends of a floating border structure. Automatic scrolling occurs while the cursor is on an end floating border structure bringing forth the content that extends beyond the field of view of the browser display window.

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Claim 1 is illustrative of the invention and reads as follows:

1. A method of automatically scrolling comprising the steps of:

(a) placing a cursor on a respective end of a floating border structure; and,

(b) in direct response to step (a), automatically scrolling through content extending beyond a display window into a field of view of the display window in a predetermined direction designated by the end.

The Examiner relies on the following prior art:

Berstis et al. (Berstis)	5,874,936	Feb. 23, 1999
Bates et al. (Bates)	6,222,541	Apr. 24, 2001
		(filed Jan. 20, 1998)

Claims 1-24, 27-34, and 36-39 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Berstis. Claims 25, 26, and 35 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Berstis in view of Bates.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief (filed August 1, 2005 and Answer (mailed September 28, 2005) for their respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections, and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in

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support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure of Berstis fully meets the invention as recited in claims 1-24, 27-34, and 36-39. In addition, with respect to the Examiner's obviousness rejection, we are of the opinion that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the appealed claims 25, 26, and 35. Accordingly, we affirm.

We consider first the Examiner's 35 U.S.C. § 102(b) rejection of claims 1-24, 27-34, and 36-39 based on Berstis. At the outset, we note that it is well settled that anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1, 10, and 11, the Examiner indicates (Answer, pages 3, 4, and 6) how the various limitations are read on the disclosure of Berstis. In particular, the Examiner directs attention to the illustration in

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Figure 2 of Berstis as well as the disclosure at column 2, lines 7-9 of Berstis.

In our view, the Examiner's analysis is sufficiently reasonable that we find that the Examiner has at least satisfied the burden of presenting a prima facie case of anticipation. The burden is, therefore, upon Appellant to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)].

Appellant's arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Berstis so as to establish a case of anticipation. In particular, Appellant's arguments focus on the contention that, in contrast to the claimed invention, Berstis does not provide for automatic scrolling in direct response to placing a cursor on the end of a floating border structure. According to Appellant (Brief, pages 8 and 9), since Berstis requires the operation of a remote pointing device in order to scroll, the benefits of Appellant's invention, i.e., a user is not required to take any action other than placing a cursor on the end of a floating border structure, are not achieved. Further, Appellant asserts (Brief, page 11) that, since scrolling in Berstis occurs in response to user operation of the remote pointing device,

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there is no disclosure of automatic scrolling in direct response to cursor placement at the end of a floating border structure as claimed.

After reviewing the language of appealed independent claims 1, 10, and 11 in light of Appellants' arguments, however, we find that such arguments are not commensurate with the scope of the claim. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

While we do not necessarily disagree with Appellant that the disclosure of Bertis does not provide the automatic scrolling feature disclosed by Appellant, it is the claimed invention that is before us on appeal. In our view, to whatever extent Appellant is relying on the feature of providing automatic scrolling without any user action, such a feature is not precluded by the language of independent claims 1, 10, and 11. In other words, while Berstis requires operation of a pointing device to place a cursor on the end of a floating border structure, such operator action is not prohibited by the claim

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language. Further, once the cursor is placed on the floating border structure end, automatic scrolling occurs in direct response to the placement of the cursor as claimed.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Berstis, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1, 10, and 11, as well as dependent claims 2-4, 6-9 and 12-20 not separately argued by Appellants, is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 102(b) rejection of separately argued dependent claim 5, we sustain this rejection as well. We find no error in the Examiner's assertion (Answer, page 12) that, in a scrolling environment such as described by Berstis, a pause will occur after it is determined that a full page scroll as commanded has occurred, all that is required by the language of dependent claim 5.

We next consider the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 21 and 31 based on Berstis. Independent claims 21 and 31 are directed to the displaying and navigating through a website page in which a displayed page is automatically scrolled "to push and allure navigation through the website, even if the user does nothing."

Appellant's arguments in response to the Examiner's rejection reiterate those made with respect to previously discussed independent claims 1, 10, and 11. As argued previously, Appellant contends (Brief, pages 12 and 13), that, in

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direct contrast to the language of claims 21 and 31, the device of Berstis requires the operator to do something, i.e., operate a pointing device in order to scroll.

It is again our view, however, that Appellant's arguments are not commensurate with the scope of independent claims 21 and 31. As pointed out by the Examiner, proper claim construction for claims 21 and 31 does not require that the language "even if the user does nothing" modify the language "automatically scrolling." We agree with the Examiner that the broadest reasonable construction of claims 21 and 31 permits the "even if the user does nothing" to modify its closest claim terminology, i.e., the language "to push and pull and allure navigation through the website."

Accordingly, we find no error in the Examiner's assertion (Answer, page 11) that once a page of web content is scrolled into view, the displayed content will cause pushing and allure without any action by the user as claimed. Therefore, since all of the claimed limitations are present in the disclosure of Berstis, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 21 and 31, as well as dependent claims 22, 23, 27-30, 32, 33, and 36-39 not separately argued by Appellants, is sustained.

We also sustain the Examiner's 35 U.S.C. § 102(b) rejection, based on Berstis, of separately argued dependent claims 24 and 34. We find no error in the Examiner's assertion that the ordinarily skilled artisan would have recognized that the content

of the web pages accessed by Berstis would have included links which would have been highlighted in some fashion to distinguish them from, for example, background text. We would further point out that it is well settled that, even if a reference fails to explicitly spell out every detail of a claimed invention, such a reference would anticipate a claim if it discloses the claimed invention "such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), quoting from In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).<sup>1</sup>

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 25, 26, and 35, directed to various blinking link features, based on the combination of Berstis and Bates. Appellant has not separately argued the limitations in these claims and instead has relied on arguments made with respect to independent claims 21 and 31, which arguments we found to be unpersuasive for all of the reasons discussed supra.

In summary, we have sustained the Examiner's 35 U.S.C. § 102(b) rejection of claims 1-24, 27-34, and 36-39, as well as the 35 U.S.C. § 103(a) rejection of claims 25, 26, and 35.

Therefore, the decision of the Examiner rejecting claims 1-39 is affirmed.

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<sup>1</sup> We make the observation that the Bates reference (U.S. Patent No. 6,222,541), of record, provides evidence (e.g. Abstract) that the ordinarily skilled artisan would have knownledged that the highlighting of links in displayed web pages is an accepted feature of the web page display art.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004).

AFFIRMED

*Joseph Ruggiero*

JOSEPH F. RUGGIERO

Administrative Patent Judge

ALLEN R. MACDONALD

Administrative Patent Judge

JEAN R. HOMERE

Administrative Patent Judge

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